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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,752	12/28/2000	Taizo Akimoto	Q61244	4934

7590 04/12/2007
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EXAMINER	
GOLDBERG, JEANINE ANNE	

ART UNIT	PAPER NUMBER
1634	

MAIL DATE	DELIVERY MODE
04/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	09/749,752	AKIMOTO, TAIZO	
	Examiner	Art Unit	
	Jeanine A. Goldberg	1634	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 3/28/07 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: NONE.
Claim(s) objected to: NONE.
Claim(s) rejected: 7,8,10,11 and 18-22.
Claim(s) withdrawn from consideration: NONE.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


Jeanine A. Goldberg
Examiner
Art Unit: 1634

Continuation of 3. NOTE: While the limitations of Claim 18 have been added to Claim 8, the limitation of Claim 18 has also been added to Claim 7, 19, 22, for example which was not previously presented. Claim 7 did not previously require the management information to identify the "type and the position of each probe." Thus, this would require further search and consideration. .

Continuation of 11. does NOT place the application in condition for allowance because: The response argues 112/6th issues for the newly amended Claims. As correctly pointed out by the response, the construction of a means-plus-function limitation required the identification of the function and the corresponding structure in the written description (i.e. the specification) that performs the function. Here, the response does not provide any guidance as to the means provided in the specification which allow attachment of management information peculiar to the test piece to a predetermined location on the test piece using a marker the same as or similar to the marker used for marking the target substance. The response merely asserts the examiner has cited references which to not teach attaching using a marker the same as or similar to the marker used for marking the target substance. The response asserts that the examiner fails the first prong of the test, however the applicant does not perform the steps of the test, as required. As specifically provided by the case law the function is identified and the corresponding structure from the specification is identified. Then the structure may be searched in the art. The art does not require teaching the specific function. Therefore applicant's arguments that the function is not presented in the art is not relevant.

The response asserts that the invention includes attachment of management information via a bar code using a printing device. The examiner has explained that the printing device encompasses a spotter and an ink jet as specifically taught on page 6, 16, and 24 of the instant specification. The art teaches the spotter, ink jet and the equivalent gel electrophoresis.

The response similarly argues Claims 11 and 21 are patentable. The response acknowledges that Shiraishi and Tsuchiya may teach the general application of a marker by a spotter or printer but does not teach attaching encoded management information for identification purposes described by Claims 11 and 21. This as described above, does not meet the test for means-plus-function claims.

The response argues the examiner places undue emphasis on generic structures without giving proper consideration to the claimed function. This argument has been reviewed but does not coincide with the teachings of MPEP 2181-2185 or the cited case law. .